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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/069,403

02/26/2002

Timo Haataja

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EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

3692

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/069,403	<b>Applicant(s)</b> HAATAJA ET AL.	
	<b>Examiner</b> Frantzy Poinvil	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment: See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-8 are directed to a method for customizing the charging or subscribers in a telecommunications network. Claims 9-12 are directed to a network element controlling charging of a subscriber in a telecommunications system. However, there are no actual steps of arriving at a tangible and concrete result. Accordingly, the claims do not produce any output being considered as a concrete and tangible result. Thus claims 1-12 are rejected as being non-statutory.

Claim 13 is directed to a network element which does not fall into any of the statutory classes of invention.

Claims 14-17 are directed to a database which does not fall into any of the statutory classes of invention.

Applicant is reminded that a database or software or computer program not claimed as embodied in computer media executable by a processor or a computer are descriptive material per se are not statutory because they are neither physical "thing" nor statutory processes. The claimed database does not define any structural and functional interrelationships with a general purpose computer for permitting the claimed functions to be realized. In contrast, a statutory

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claim would define structural and functional interrelationships between data structures or functional parts and a computer for performing the data functions to be realized and would result in a useful, tangible and concrete result. Thus, the claims do not result in any tangible and concrete result. Thus claims 13-17 are also rejected as being non-statutory for failing to produce a useful, concrete and tangible result.

### ***Claim Rejections - 35 USC § 112***

2. Claims 9-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 9, the claim is directed to a system claim but comprises no means or structure to perform the claimed functions.

Similarly, claim 13 is directed to a network element which does not fall into any of the statutory classes of invention and thus is being unclear how such can be a telecommunications system.

Claims not directly addressed are rejected based on their dependency.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Neil (US Patent No. 6,226,364).

As per claims 1 and 9, O'Neil discloses a system and method for providing prepaid and credit-limited telephone services. The system and method comprise:

Maintaining subscriber information on at least one subscriber (this is similar to the user profile of O'Neil);

Defining at least two different tariff models (local and long distance and international rates and roaming rates), each model containing a tariff scheme defining how to charge a call;

Indicating in the subscriber information directly or indirectly which tariff model is to be used with this subscriber (based on the calling or dialed number); and

Charging the subscriber according to the tariff scheme of the indicated tariff model. See column 14, lines 1-12 of O'Neil.

As per claims 2 and 10, O'Neil discloses defining one tariff (the local rate) to be a default model which is used when no other tariff model is indicated. See column 11, lines 48-65, column 10, lines 9-23 and column 15, lines 39-52 of O'Neil.

As per claims 3 and 11, O'Neil discloses the telecommunications network offers a prepaid service to its subscribers and the at least one subscriber is a prepaid subscriber. See the abstract.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-8 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil (US Patent 6,226,364).

As per claims 4, 7 and 14, the teachings of O'Neil are discussed above. O'Neil discloses a prepaid card system and method using at least two different types of vouchers or payment systems such as a credit card or debit card for making deposits into subscribers prepaid accounts (column 4, lines 57-65). O'Neil does not explicitly state attaching one tariff model at least to each of the two different types of vouchers or indicating in the subscriber information the type of voucher this subscriber is currently using and determining the tariff model to be used on the basis of the voucher this subscriber is currently using. However, it is well known in the art at the time of the invention that "A prepaid service is a service where a subscriber pays in advance his calls by buying vouchers. The prepaid service logic and prepaid service data are stored in the system...the prepaid service enables roaming subscribers to pay their local calls at local tariffs, whereas the use of the SIM card of their home service provider results in paying international tariffs to their home network and back". Charging or billing one tariff model to a type of voucher would have been left to the owners of the system of O'Neil since doing so would have been left as an agreement between the owners and the users or clients of the system of O'Neil. The motivation to introduce such a billing scheme in the system and method of O'Neil would

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have been to redistribute types of charges to a credit card or a billing card in case one of the client's billing card become exhausted.

As per claims 5 and 6, 12, in depositing funds from a voucher or billing card, the user's subscriber information must be checked and if the voucher or billing card is an allowed one (based on sufficient funds or based on correct Id, PIN or password), then continuing depositing and if the voucher is not an allowed one, terminating depositing (column 19, line 48 to column 20, line 2 and column 22, lines 11-63).

As per claims 9 and 13 and 15-17, O'Neil discloses a system and method for providing prepaid and credit-limited telephone services. The system and method comprise:

Maintaining subscriber information on at least one subscriber (this is similar to the user profile of O'Neil). O'Neil discloses using at least two different types of vouchers or payment systems such as a credit card or debit card for making deposits into subscribers prepaid accounts (column 4, lines 57-65). O'Neil does not explicitly state attaching one tariff model at least to each of the two different types of vouchers or indicating in the subscriber information the type of voucher this subscriber is currently using and determining the tariff model to be used on the basis of the voucher this subscriber is currently using. However, it is well known in the art at the time of the invention that "A prepaid service is a service where a subscriber pays in advance his calls by buying vouchers. The prepaid service logic and prepaid service data are stored in the system...the prepaid service enables roaming subscribers to pay their local calls at local tariffs, whereas the use of the SIM card of their home service provider results in paying international tariffs to their home network and back". Charging or billing one tariff model to a type of voucher would have been left to the owners of the system of O'Neil since doing so would have

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been left as an agreement between the owners and the users or clients of the system of O'Neil. The motivation do introduce such a billing scheme in the system and method of O'Neil would have been to redistribute types of charges to a credit card or a billing card in case one of the client's billing card become exhausted.

The system and method finding out which of the defined tariff models to be used with a subscriber from the subscriber information in defining how to charge a call would have been obvious to one of ordinary skill in the art to do especially in the case one of the subscriber's vouchers become exhausted thus, allowing alternate means or form of payment to enable a call transaction or in the case roaming charges need to be assessed.

### ***Conclusion***


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Frantzy Poinvil**  
**Primary Examiner**  
**Art Unit 3692**

FP  
March 31, 2007